

REMARKS/ARGUMENTS

Prior to entry of this amendment, claims 1-13 were pending in the application. An Office Action mailed September 22, 2005, rejected claims 1-13 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action also rejected claims 1-13 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Finally, the Office Action rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,877,137 (“Rivette”) and rejected claims 2-13 under 35 U.S.C. § 103(a) as being unpatentable over Rivette in view of U.S. Publication No. 2004/0181427 (“Stobbs”).

This amendment amends claims 1-4 and adds claims 14-20. Hence, after entry of this amendment, claims 1-20 stand pending for examination.

Claim Amendments

Claim 1 has been amended to remove unnecessary elements and to enhance the clarity of that claim. The element “storing a plurality of electronic documents in a database” has been deleted, and the new element “providing a user with access to a plurality of electronic documents” has been added. The added element is supported throughout the application, including, in particular, lines 8-24 on page 17, lines 28-34 on page 24, lines 1-17 on page 25, and lines 9-20 on page 30.

Claim 1 has also been amended to recite that “the first case corresponds to a first patent application” and, similarly, that “the second case corresponds to a second patent application.” Support for these amendments can be found throughout the application, including, in particular, lines 29-34 on page 12.

Claim 1 has been further amended to recite that “associating the first set of electronic documents with the first case comprises identifying the first set of electronic documents as relevant to the first patent application” and, similarly, that “associating the second set of electronic documents with the second case comprises identifying the second set of

electronic documents as relevant to the second patent application.” Support for these amendments can be found throughout the application, including, in particular, page 5, line 32, through page 6, line 7.

Finally, claim 1 has been amended, for enhanced readability, to recite “a first set of electronic documents, comprising one or more of the plurality of electronic documents” and “a second set of electronic documents, comprising one or more of the plurality of electronic documents,” and to correct typographical and grammatical errors. Claim 3 has been amended in similar fashion, while claims 2 and 4 have been amended to comport with the amendments to claim 1.

New claim 14 recites the element deleted by the amendment to claim 1. New claim 15 recites that “providing a user with access to a plurality of electronic documents comprises storing in a database information from at least some of the plurality of electronic documents.” Support for these amendments can be found throughout the application, including, in particular, lines 24-27 on page 6.

New claim 16 recites “wherein providing a user with access to a plurality of electronic documents comprises allowing a user to search the web for electronic documents,” while new claim 17 recites “wherein providing a user with access to a plurality of electronic documents comprises allowing a user to search a database of electronic documents,” and new claim 18 recites that “the database is maintained by an official patent office.” Support for these amendments can be found throughout the application, including, in particular, lines 23-28 on page 5, and lines 1-32 on page 8.

New claims 19 and 20 recite a system and computer program, respectively, that correspond to claim 1. Support for claims 19 and 20 can be found throughout the application, including, in particular, claim 1 (and the portions of the application supporting claim 1), as well as lines 9-18 on page 7, and Fig. 1 (and the corresponding portion of the specification).

§ 112 Rejections

The Office Action rejected claims 1-13 under § 112, paragraph 2, as being indefinite. In particular, the Office Action objected to the use of the term “associating” in claim 1. Claim 1 has been amended to more clearly define what is meant by the term “associating,” as it is used in that claim. It is believed that the amendments to claim 1 overcome the rejections in this regard. The Office Action also objected to the term “the plurality of electronic patent documents” as recited by claims 2 and 3. These claims have been amended to delete the offending phrase, and it is believed that these amendments overcome the rejections on that ground. Reconsideration of the § 112 rejections in view of these amendments would be gratefully appreciated.

§ 101 Rejections

The Office Action also rejected claims 1-13 under § 101 as being directed to non-statutory subject matter. In particular, the Office Action asserted that the claims are not grounded in the technological arts. These rejections are respectfully traversed, for at least the following reasons.

First, the BPAI has firmly rejected the “technological arts” requirement as a legitimate ground for rejecting a patent claim under § 101. *Ex Parte Lundgren*, 76 U.S.P.Q.2d 1385, 1388 (BPAI 2004) (“[T]here is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under § 101. We decline to create one.”). Accordingly, it is believed that the rejection of claims 1-13 for failing to meet a “technological arts” requirement is unsupported by law, and reconsideration of the rejection on that ground is respectfully requested.

More broadly, the § 101 rejection of claims 1-13 seems to assert that the claims are drawn only to an abstract idea. The Applicants respectfully disagree. Claim 1 recites a method that can be implemented only with a computer (for example, the step of providing access to an electronic document cannot be performed without the use of a computer) and produces a

useful, tangible and concrete result (identification of one or more electronic documents as relevant to one or more patent applications). Accordingly, it is believed that claim 1 (and, by extension, claims 2-13 which depend therefrom) falls well within the requirements of § 101. Reconsideration of the rejection is respectfully requested.

§ 102 Rejections

The Office Action rejected claim 1 under § 102(e) as being anticipated by Rivette. This rejection is respectfully traversed, at least because Rivette fails to teach or suggest each element of any pending claim. Take, for example, claim 1, which recites, inter alia, “associating a first set of electronic documents, comprising one or more of the plurality of electronic documents, with a first case, wherein the first case corresponds to a first patent application, and wherein associating the first set of electronic documents with the first case comprises identifying the first set of electronic documents as relevant to the first patent application.”

Rivette fails to teach or suggest at least this element of claim 1. In fact, Rivette has nothing whatsoever to do with identifying an electronic document as relevant to a patent application. Instead, Rivette is directed to “[a] system and method of manipulating notes linked to Web pages, and of manipulating the Web pages.” Rivette, Abstract.

Rivette also fails to teach or suggest either “allowing the user to select at least one electronic document in the second set to be associated with the first case” or “associating the selected at least one electronic document with the first case,” as recited by claim 1. The Office Action asserts that column 31, lines 35-63, and column 30, lines 36-59, of Rivette teach these elements of claim 1. The first cited passage teaches only that a user might provide one of a variety of commands, which can be used, for example, to launch an application, create a new note/sub-note, view a note, e-mail a portion of a notes database, find text, modify security settings, view and/or hide notes, toggle views and the like. *See* Rivette, column 31, lines 35-63. This passage does not teach or suggest, however, “allowing the user to select at least one electronic document in the second set to be associated with the first case,” as recited by claim 1.

Likewise, while the second cited portion teaches the concept of bookmark links, it does not teach “associating the selected at least one electronic document with the first case,” as recited by claim 1.

For at least these reasons, Rivette fails to anticipate claim 1, and the Applicants respectfully request the withdrawal of that rejection. Independent claims 19 and 20, which recite similar elements, are believed to be allowable for at least similar reasons.

§ 103 Rejections

The Office Action rejected claims 2-13 under § 103(a) as being unpatentable over Rivette in view of Stobbs. This rejection is respectfully traversed as well, for at least the following reasons.

In order to establish a *prima facie* case of obviousness under § 103, an asserted combination of references must meet three criteria. First, the references must teach, either individually or in combination, each element of the rejected claim; second, there must be some motivation or suggestion to combine the references; and third, there must be a reasonable expectation of success in the combination. MPEP § 2143. The combination of Rivette and Stobbs fails to meet these three criteria, and the combination, therefore, fails to support a *prima facie* case that any pending claim is obvious under § 103.

Consider, for example, claim 1. As noted above, Rivette fails to teach or suggest multiple elements of claim 1. Moreover, Stobbs fails to supply the disclosure missing from Rivette. Stobbs is directed to “[a] computer-implemented apparatus and method for performing patent portfolio analysis . . . [, which] clusters a group of patents based on one or more techniques.” Stobbs, Abstract. More particularly, Stobbs teaches a sophisticated procedure for analyzing claims of issued patents to organize patent portfolios. *Id.*, ¶ 0002. Stobbs does not teach or suggest, however, “associating a first set of electronic documents, comprising one or more of the plurality of electronic documents, with a first case, wherein the first case corresponds to a first patent application, and wherein associating the first set of electronic

documents with the first case comprises identifying the first set of electronic documents as relevant to the first patent application,” as recited by claim 1. Nor does Stobbs teach or suggest either “allowing the user to select at least one electronic document in the second set to be associated with the first case” or “associating the selected at least one electronic document with the first case,” as recited by claim 1. In fact, Stobbs teaches removing all data but the claims (and a few selected bibliographic fields) from patents before analysis, so it would be impossible for Stobbs to identify an analyzed patent as relevant to a given patent application, since the written description of the patent is removed before analysis. *See Id.*, ¶ 0053, Figs. 3-4.

Accordingly, even if there were a motivation to combine Stobbs with Rivette, and a reasonable expectation of success in the combination (neither of which the Applicants concede), the combination would still fail to create a prima facie case of obviousness with respect even to independent claim 1, because the references fail, both separately and in combination, to teach or suggest each element of that claim. Claim 1, therefore, is believed to be allowable over the combination of Rivette and Stobbs. For at least similar reasons, independent claims 19 and 20 are believed to be allowable, as well. Dependent claims 2-18 each depend ultimately from claim 1, and they are believed to be allowable at least because of their dependence from an allowable base claim.

Conclusion

In view of the foregoing, the Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Application No. 09/919,787
Amendment dated March 22, 2006
Reply to Office Action of September 22, 2005

PATENT

If the Examiner continues to believe that the claims are unpatentable over the combination of Rivette and Stobbs, the undersigned respectfully requests a telephone interview to discuss the rejections. The undersigned can be reached by telephone at 303-571-4000 to schedule the telephone interview.

Respectfully submitted,



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Date: March 22, 2006

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